



**CERTIFICATE OF MAILING**

I hereby certify that this paper or fee is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date listed below.

Dated: APRIL 7, 2004

  
Mary R. Zimmerman

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application for:

Carlo BALLATORE et al.

Serial No.: 10/714,255

Filing Date: November 14, 2003

For: PEPTIDE DEFORMYLASE ACTIVATED  
PRODRUGS

Confirmation No.: 3615

Examiner: Not Yet Assigned

Group Art Unit: 1623

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR §§ 1.97 and 198, the items identified in this Supplemental Information Disclosure Statement (IDS) are being brought to the attention of the Office. The items are listed on the attached forms PTO/SB/08a and PTO/SB/08b. The Examiner is requested to make these documents of record.

The items identified in this IDS may or may not be "material" pursuant to 37 CFR § 1.56. The submission thereof by Applicants is not to be construed as an admission that any such patent, publication or other information referred to therein is material or considered to be material (37 CFR § 1.97(h)), or even qualifies as "prior art" under 35 USC § 102 with respect to this invention unless specifically designated by Applicants as such.

**1. Timing of the Information Disclosure Statement:**

☒ This IDS is believed to be timely in that it is being submitted under 37 CFR § 1.97(b), that is (1) with the new patent application submitted herein (37 CFR § 1.97(a)); or (2) within three months of

the filing date of the application, which is not a continued prosecution application filed under § 1.53(d) or (3) within three months of entry of the national stage as set forth in 37 CFR § 1.491; or (4) before the mailing of a first Office action on the merits; or (5) before the mailing of a first Office action after filing a request for continued examination under § 1.114. Thus, no fee is required.

☒ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and charge the fee due under 37 CFR § 1.17(p) to the deposit account referenced below.

☐ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and a statement under 37 CFR § 1.97(e) is included below, thus no fee is required.

☐ This IDS is being submitted under 37 CFR § 1.97(c), that is after mailing of a first Office Action on the merits, but before a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311.

☐ The fee due under 37 CFR § 1.17(p) is submitted herewith.

☐ The fee due under 37 CFR § 1.17(p) is being concurrently submitted with the filing of an electronic IDS submission. Thus, no additional fee is required.

☐ A statement under 37 CFR § 1.97(e) is included below, thus no fee is required. In the event that this IDS is not received before a Final Action or a Notice of Allowance, then Applicant respectfully requests that the Office consider the filing of these papers to be submitted under 37 CFR § 1.97(d) and charge the fee due under 37 CFR § 1.17(p) to the deposit account below.

☐ This IDS is being submitted under 37 CFR § 1.97(d), that is after a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee. A statement under 37 CFR § 1.97(e) is included below. The fee due under 37 CFR § 1.17(p) is submitted herewith.

☐ This IDS is being submitted under 37 CFR § 1.97(i), that is after a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee.

**STATEMENT UNDER 37 CFR § 1.97(e):**

☐ No item contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS.

☐ No item contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this statement after making

reasonable inquiry, no item of information contained in this IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this IDS.

**2. Copies of the Cited Items:**

☐ Copies of all of the items listed on the attached forms PTO/SB/08a and PTO/SB/08b are enclosed.

☒ Copies of only the following items listed on the attached forms PTO/SB/08a (Item Nos. 9) and PTO/SB/08b (Item Nos. 3) are enclosed.

☐ Copies of all items listed on the attached form PTO/SB/08a are not enclosed. See 37 CFR 1.98(a)(2)(i).

☒ Copies of the following documents listed in PTO/SB/08a (Item Nos. 1-8, 10) and PTO/SB/08b (Item Nos. 1-2) are not supplied as they were previously cited by the Office or submitted in Information Disclosure Statements in related applications (Application No. 10/142/089, filed May 9, 2002) and relied upon in this application for an earlier filing date under 35 USC § 120. See 37 CFR § 1.98(d). The Examiner is requested to make these documents of record.

☐ Copies of the following items listed on the attached forms PTO/SB/08a (Item Nos. \*) and PTO/SB/08b (Item Nos. \*) were cited in a foreign examination report in a related case. A copy of the search report and the cited references not already of record in this application are attached hereto.

**3. Concise Explanation of Relevance:**

☒ A concise explanation of relevance of the items listed on forms PTO/SB/08a and PTO/SB/08b is not given.

☐ A concise explanation of relevance of [some of] the items listed on forms PTO/SB/08a and PTO/SB/08b is in the form of an English language copy of a Search Report from a foreign patent office, issued in a counterpart application, which refers to the relevant portions of the references (copy attached).

#### 4. Related Applications:

☒ Applicant(s) bring to the Office's attention the following related application(s): U.S. Patent Application Serial No. 10/142/089, filed May 9, 2002, and Application Serial No. 10/511,489 filed October 15, 2004.

#### 5. Conclusion:

Citation of the above documents shall not be construed as:

1. an admission that the documents are necessarily prior art with respect to the instant invention;
2. a representation that a search has been made, other than as described above; and
3. an admission that the information cited herein is, or is considered to be, material to patentability as defined in § 1.56(b).

It is respectfully requested that the Examiner indicate consideration of the cited references by returning a copy of the attached forms PTO/SB/08a and PTO/SB/08b with initials or other appropriate marks. In the unlikely event that the transmittal letter is separated from this document and the U.S. Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-2518** referencing **7008422002**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: April 7, 2005

By: Antoinette F. Konski  
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Substitute for form 1449A-PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet

1

of

1

**Complete if Known**

Application Number	10/714,255
Filing Date	November 14, 2003
First Named Inventor	Carlo BALLATORE
Art Unit	1623
Examiner Name	Not Yet Assigned
Attorney Docket Number	NB 2020.01

**U.S. PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number – Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YY	Name of Patentee or Application of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	1	US-4,053,638	10-11-77	Litchfield et al.	
	2	US-4,083,974	04-11-87	Turi	
	3	US-4,339,440	07-13-82	Bajusz et al.	
	4	US-5,918,568	07-06-99	Gjerlov	
	5	US-6,110,908	08-29-00	Guthery	
	6	US-6,143,790	11/07/00	Hallinan et al.	
	7	US-6,448,058 B1	09-10-02	Patel et al.	
	8	US-6,613,879 B1	09-02-03	Firestone et al.	

**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> – Number <sup>4</sup> – Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YY	Name of Patentee or Application of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
	9	WO 02/089739 A2	11-14-02	NewBiotics, Inc.		
	10	WO 03/088913 A2	10-30-03	NewBiotics, Inc.		

Examiner's  
SignatureDate  
Considered

\* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

The collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2.0 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 and select option 2.

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**Complete if Known**

Substitute for form 1449B-PTO

# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

*(use as many sheets as necessary)*

Sheet	1	of	1
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Application Number

**10/714,255**

Filing Date

November 14, 2003

**First Named Inventor****Carlo BALLATORE**

Art Unit

1623

Examiner Name \_\_\_\_\_

**Not Yet Assigned**

Attorney Docket Number

**NB 2020.01**

## NON PATENT LITERATURE DOCUMENTS

[illegible]

**Examiner's  
Signature**

Date  
Considered

\* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.98. This information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 120 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission	8	Application Number	10/714,255
		Filing Date	November 14, 2003
		First Named Inventor	Carlo BALLATORE
		Art Unit	1623
		Examiner Name	Not Yet Assigned
		Attorney Docket Number	NB 2020.01

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Change of Correspondence Address (1 page); Form PTO/SB/08a(1 page); Form PTO/SB/08b (1 page); 2 references; postcard receipt
<b>Remarks</b>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm	Bingham McCutchen LLP		
Signature			
Printed Name	Antoinette F. Konski		
Date	April 7, 2005	Reg. No.	34,202

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Mary R. Zimmerman	Date	April 7, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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